

REMARKS

In the Office Action, the Examiner indicated that claims 1 through 11 are pending in the application and the Examiner rejected all claims.

Rejection of Claims 1-11

On page 2 of the Office Action, the Examiner rejected claims 1-4, 6-8 and 11 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,275,810 to Waldmeier.

On page 4 of the Office Action, the Examiner rejected claim 5 under 35 U.S.C. §103(a) as being unpatentable over Waldmeier.

On page 4 of the Office Action, the Examiner rejected claims 9 and 10 under 35 U.S.C. §103(a) as being unpatentable over Waldmeier in view of U.S. Patent No. 5,133,451 to Boyd et al.

The Present Invention

The present invention discloses a portable device for receiving an electronic component used for wireless communications, such as a wireless transmitter or receiver. The portable device includes a body for accommodating the electronic component. The portable device includes an upper case and a lower case, each having a cavity. A holding member holds the peripheral portions of the upper case and the lower case such that the upper case and lower case are connected to each other with the cavities opposed to each other, creating a space for storing and completely enclosing the electronic component. By removing the holding member,

the upper case can be removed from the lower case and the electronic component can be removed.

U.S. Patent No. 4,275,810 to Waldmeier

U.S. Patent No. 4,275,810 to Waldmeier teaches a secure package for transport of precious stones. The package comprises a two part transparent core defining a first space for receiving the stone and a second space for receiving a data carrier such as a microfilm containing all of the identification information for the stone. The core is held together by a two part ring which can be separated only upon destruction of the package or the information carried thereby. Additionally, one or both of the two parts of the outer ring can be provided with an electronic circuit having a terminal which can be connected to a monitoring or reading device such that the circuit can provide indicia of the contents of the package. The Examiner acknowledges that Waldmeier fails to disclose "permitting receipt and transmission of wireless signals therethrough for communication with the wireless component". Additionally, the Examiner acknowledges that Waldmeier fails to disclose the package is made of a synthetic resin or that the two holding members are attached to the portable device in directions intersecting a line perpendicular to the plane of the portable device.

U.S. Patent No. 5,133,451 to Boyd et al.

U.S. Patent No. 5,133,451 to Boyd et al. ("Boyd") teaches a container for storage, display and protection of collectable items such as graded coins, stamps, jewels and other

valuables. The container comprises an enclosed cavity for storage of the item as well as a multi-piece enclosure for securing the item in the cavity. The Examiner relies on Boyd to teach that two holding members are attached to the container in directions intersecting a line perpendicular to the plane of the portable device.

The Cited Prior Art Does Not Anticipate the Claimed Invention

The MPEP and case law provide the following definition of anticipation for the purposes of 35 U.S.C. §102:

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.”
MPEP §2131 citing *Verdegaal Bros. v. Union Oil Company of California*, 814 F.2d 628, 631, 2 U.S.P.Q. 2d 1051, 1053 (Fed. Cir. 1987)

The Office Action acknowledges that Waldmeier “does not specifically disclose” a structure permitting receipt and transmission of wireless signals therethrough for communication with an electronic component. Nonetheless, the Office Action rejects claims 1 and 11 as anticipated by Waldmeier, alleging that the disclosed structure is capable of performing the foregoing function.

The above amendment revises claims 1 and 11 to recite additional structure that Waldmeier does not disclose. Specifically, claims 1 and 11 as amended each recite the portable device as comprising “an electronic component which receives and transmits wireless signals”. Waldmeier does not disclose this feature.

In contrast, Waldmeier teaches a data carrier (8), which is a microfilm, and an integrated circuit (15) having terminals (16). To read data carrier (8), peripheral equipment is connected to the terminals (16) (see Col. 4, lines 14-21).

Alternatively, Waldmeier teaches a microcomputer of memory in place of the integrated circuit (15). Even in this case, however, access to the microcomputer or memory must be made via connection to the terminals (16) (see Col. 4 lines 22-30).

Thus, communication in Waldmeier is not conducted via wireless signals, rather the communication is performed via connection of wires through the terminals (16). Despite the disclosure of an alternative embodiment of Waldmeier, there is no suggestion for wireless communication.

Accordingly, claims 1 and 11 as amended both distinguish over Waldmeier. Each claim recites a portable device comprising “an electronic component which receives and transmits wireless signals”. Waldmeier does not disclose or suggest structure capable of performing the recited function. Hence, the prior art does not teach the recited functional limitation under MPEP 2114.

As provided in MPEP 706.02 “for anticipation under 35 U.S.C. 102, the reference must teach every aspect of the claimed invention either explicitly or implicitly. Any feature not directly taught must be inherently present.” Further in support of this requirement, MPEP 2131 quotes the Court of Appeals for the Federal Circuit in *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (1989) stating that “[t]he identical invention must be shown in as complete detail as is contained in the ... claim.” Waldmeier does not satisfy

the foregoing requirements with respect to claims 1 and 11 as amended and the amended claims are therefore not anticipated.

Neither are claims 1 and 11 as amended obvious in view of Waldmeier. Waldmeier teaches communication requiring connection to terminals (16), which is contrary to the claimed invention. As stated in MPEP 2145 “[a] prior art reference that ‘teaches away’ from the claimed invention is a significant factor to be considered in determining obviousness.”

Therefore, reconsideration and withdrawal of the rejection of each of claims 1 and 11 is respectfully requested. Likewise, the same is requested for the remaining claims in the application, as all of the remaining claims depend from claim 1.

The Examiner has not Established a *prima facie* Case of Obviousness

As set forth in the MPEP:

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skilled in the art, to modify the reference or to combine reference teachings.

MPEP 2143

For the reasons stated above in reference to the 102(b) rejections, Waldmeier fails to disclose the claimed invention. The addition of the teachings of Boyd to Waldmeier also fails to suggest the claimed invention. Boyd teaches a storage and protection system for precious items such as coins and stones. Boyd is not concerned with enclosing an electric device that is capable of receiving and transmitting wireless signals. For this reason, Waldmeier and Boyd, whether considered alone or in combination, fail to teach or suggest the claimed invention.

The Examiner is respectfully requested to reconsider and withdraw the rejections of claim 5 under 35 U.S.C. §103(a) based on the combination of Waldmeier in view of the background of the present invention as well as the rejections of claims 9-10 under 35 U.S.C. §103(a) based on the combination of Waldmeier in view of Boyd.

Conclusion

The present invention is not taught or suggested by the prior art. Accordingly, the Examiner is respectfully requested to reconsider and withdraw the rejection of the claims. An early Notice of Allowance is earnestly solicited.

The Commissioner is hereby authorized to charge any fees associated with this communication to Deposit Account No. 19-5425.

Respectfully submitted,

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Date



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